

REMARKS

[0001] The Examiner objected to claims 15-17, and 19 but notes that these claims would be allowable if rewritten in independent form. The Examiner rejected Claims 11, 13, 14, and 18 under 35 U.S.C. §102(b) as anticipated by Japanese Patent JP 4-221474A to Ogawa et al. (hereinafter “Ogawa”). The Examiner rejected Claim 12 under 35 U.S.C. §103(a) as being unpatentable over Ogawa in view of US Patent No. 5,184,265 to Foote et al (hereinafter “Foote”) in combination with US Patent No. 6,391,216 to Nakatani (hereinafter “Nakatani”).

[0002] The claims have been amended to address the rejection of claims 11, 12, 13, 14, and 18. For reasons set forth below, Applicant respectfully requests that the rejections be withdrawn and that claims 1-24 be allowed.

REJECTION OF CLAIM 11, 13, 14, AND 18 UNDER 35 U.S.C. §102(b)

[0003] The Examiner rejected claims 11, 13, 14, and 18 under 35 USC §102(b) in view of Ogawa. Applicant has amended Claims 1 and 11 to further clarify the invention.

[0004] Specifically, claim 11, as amended, specifies “a movable member formed as an integral part of the read/write slider” *See* amended claim 11. The Merriam-Webster dictionary defines the term integral as essential to completeness, and lacking nothing essential; entire. The term entire is further defined as consisting of one piece. As described in the specification, one embodiment of the movable member is formed from the same block of material as the slider. This is done in one embodiment by etching away a portion of the slider. *See* lines 10-12 of page 10, lines 1-6 of page 14, and lines 20-24 of page 14 of the specification. The specification specifically states that the movable member and the read/write slider are formed from the same block of material. The movable member and the slider are an entire unit. Therefore, the movable member is formed as an integral part of the slider without the aid of a fastening or securing mechanism. Applicant has amended Claim 1 to further clarify the invention by describing formation of a movable member as an integral part of the read/write slider.

[0005] Ogawa discloses a head supporting spring mechanism, which could also be called a movable member, that is not an integral part of a head. Rather, the head supporting spring mechanism is attached to the head using some type of connecting member such as glue, rivets, screws, or the like. Ogawa does not disclose a head supporting spring mechanism formed from the same piece of material as the head. Consequently, the head supporting spring mechanism disclosed by Ogawa is coupled, but not *an integral part of* the head.

[0006] It is well settled that under 35 U.S.C. §102 that “an invention is anticipated if . . . all the claim limitations [are] shown in a single art prior art reference. Every element of the claimed invention must be literally present, arranged as in the claim. The identical invention must be shown in as complete detail as is contained in the patent claim.” *Richardson v. Suzuki Motor Co., Ltd.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Therefore, only if each limitation is literally disclosed by the prior art reference is the claim anticipated.

[0007] Applicant respectfully asserts that Ogawa fails to identically show each element in amended independent Claim 11. Namely, Ogawa fails to teach “a movable member *formed as an integral part of* the read/write slider.” Therefore, every element of the claimed invention is not literally present, arranged as in the claim. *Richardson v. Suzuki Motor Co., Ltd.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). The identical invention is not shown in as complete detail as is contained in the patent claim. *Id.* Applicant respectfully submits that independent Claim 11 is patentably distinct from Ogawa.

[0008] The Examiner rejected claims 13, 14, and 18 under 35 USC §102(b) in view of Ogawa. However, since Claims 13, 14, and 18 depend from amended Claim 11, the Applicant respectfully submits that Claims 13, 14, and 18 are also patentably distinct from Ogawa.

REJECTION OF CLAIM 12 UNDER 35 U.S.C. §103(a)

[0009] The Examiner rejected Claim 12 under 35 U.S.C. §103(a) as being unpatentable over Ogawa in view Foote in combination with Nakatani. Applicant has amended Claim 11 from with Claim 12 depends to further clarify the invention as discussed above.

[0010] The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See MPEP § 2142. To establish *prima facie* obviousness, there must be some suggestion or motivation to modify the reference or to combine reference teachings to arrive at the claimed invention. "The teaching or suggestion to make the claimed combination ... must be found in the prior art, not in applicant's disclosure." MPEP 2143, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." See *MPEP 2143.01*, citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

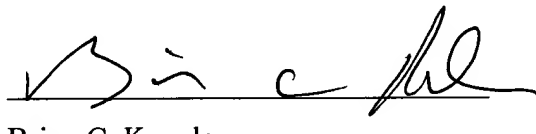
[0011] Although Nakatani does indicate that stainless steel is etchable, he elaborates further to state that stainless steel is only etchable using Reactive Ion Etch (RIE) processes suitable for etching other metal alloys composed of transitional metals possessing magnetic properties. Nakatani states that stainless steel is used for constitutional parts of a standard RIE apparatus, because it is not etchable by RIE processes used to etch generally accepted reactive ion etchable material. Claim 12 clearly states that the movable member comprises a generally accepted reactive ion etchable material. The possibility of etching stainless steel as described in Nakatani is an undesirable effect of one specific application of RIE resulting in significant modifications to a standard RIE apparatus. Stainless steel is not described as a generally accepted reactive ion etchable material. Therefore, the Applicants respectfully assert that no motivational advantage can be found in combining Ogawa with Foote and Nakatani.

[0012] Additionally, to establish a *prima facie* case of obviousness, the combination of the prior art references must teach or suggest all the claim limitations. MPEP § 2142.

[0013] Applicants respectfully assert that the combination of Ogawa, Foote, and Nakatani fails to teach or suggest all the claim limitations of amended independent Claim 11 from which Claim 12 depends. Specifically, Ogawa fails to teach or disclose “a movable member *formed as an integral part of* the read/write slider.” Accordingly, Applicant respectfully asserts that claim 12 is allowable in view of amended Claim 11 because neither Ogawa nor Chou teach or disclose the missing elements of amended Claim 11.

[0014] In view of the foregoing, Applicants submit that the application is in condition for allowance. In the event any questions or issues remain that can be resolved with a phone call, the Examiner is respectfully requested to initiate a telephone conference with the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'B. C. Kunzler', written over a horizontal line.

Brian C. Kunzler
Reg. No. 38,527
Attorney for Applicant

Date: December 22, 2004
8 East Broadway, Suite 600
Salt Lake City, UT 84111
Telephone (801) 994-4646
Fax (801) 322-1054